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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 974,882	10 10 2001	Edward M. Nolan	GENE1320-2	8790

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EXAMINER

PAPPU, SITA S

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 05.20.2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/974,882

Applicant(s)

NOLAN ET AL.

Examiner

Sita Pappu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 and 23-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Claims 1-21, 23-25 are pending in the instant application. Claim 22 has been cancelled by the Applicant in the preliminary amendment filed in paper # 2 on 10/10/2001. This Office Action is in response to the communication filed by the Applicant in paper # 4, on 03/29/2002.

Election/Restrictions

The previous restriction requirement mailed on 02/13/2002 is withdrawn in favor of the following restriction.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, drawn to a method for the delivery of at least one chromosome into eukaryotic cell using a laser light pulse and confirmation by FACS, classified in class 435, subclass 460.
- II. Claim 17, drawn to an apparatus for the delivery of at least one chromosome into eukaryotic cell using a laser light pulse, and a FACS means for confirming, classified in class 435, subclass 285.1.
- III. Claims 18-19, drawn to a method for the delivery of at least one chromosome into eukaryotic cell using a linear accelerator and confirmation by FACS, classified in class 435, subclass 459.
- IV. Claim 20, drawn to an apparatus for the delivery of at least one chromosome into eukaryotic cell using a linear accelerator, and a FACS means for confirming, classified in class 435, subclass 285.3.

- V. Claims 21, 24, 25, drawn to a method for the delivery of at least one chromosome into eukaryotic cell using an electric pulse and confirmation by FACS, classified in class 435, subclass 461.
- VI. Claim 23, drawn to an apparatus for the delivery of at least one chromosome into eukaryotic cell using an electric pulse, and a FACS means for confirming, classified in class 435, subclass 285.2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II, III and IV, and V and VI are pairwise related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus is a combination of apparatus for performing each of the steps of inserting and confirming separately. Additionally, a chromosome could be inserted using ultrasonic means or chemical means.

Inventions I, III and V, and II, IV and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions within each Grouping each involve different means of introducing chromosomes into cells.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and

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because of their recognized divergent subject matter, and the search required for one Group is not required for another Group, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sita S Pappu whose telephone number is (703) 305-5039. The examiner can normally be reached on Mon-Fri (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached on (703) 305 1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308 4242 for regular communications and (703) 872 9307 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-2982.

S. Pappu
April 26, 2002

Anne-Marie Baker
ANNE-MARIE BAKER
PATENT EXAMINER